

**REMARKS**

**STATUS OF CLAIMS:**

Claims 8, 11, 27 and 30, all of which are rejected, are pending in this application.

**35 U.S.C. §103:**

Claims 8, 27 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kudo (U.S. Patent No. 4,992,815). In the previous Amendment dated July 10, 2003, claims 8 and 30 were amended to recite a bundle of photosensitive printing plates, "which are not sealed within a light-shielding wrapper." The Examiner acknowledges the Kudo does not disclose this feature and attempts to rely on *In re Karlson*, 50 CCPA; 908, 136 USPQ 184 (1963), for an assertion that it would have been obvious to not wrap the bundle of sheets of Kudo in a light-shielding wrap "since it has been held that omission of an element and its function in combination where the remaining elements perform the same functions as before involves only routine skill in the art." Applicants respectfully point out to the Examiner that the application of this reasoning in the present situation is improper.

The issue in *In re Karlson* was whether it would have been obvious to remove a screen and filler tube from a chemical tank of a prior art reference so as to teach a claimed "unobstructed" interior space of a chemical tank. The Court agreed that it would not be unobvious to eliminate a screen and filler tube of the prior art reference "if it was desired to introduce the solution into the tank in some other manner." (*Id.* at 909.) The Court based this conclusion on the fact that in the applied prior art reference, "the water circulation and entrainment of chemical

solution in the Shuldener device would still function in the same manner if the screen and filler tube were removed.” (Emphasis added.) (*Id.* at 910.)

It is apparent that the facts in *In re Karlson*, which led to the Court’s decision, are different than the present case, such that the Court’s analysis would not apply to the present case. This is because if the light shielding wrap 12 were removed from the device of Kudo, then the device would not still function in the same manner as when light shielding wrap 12 is in place. In particular, the bag 12 of Kudo is an integral feature of the reference that is disclosed as having an end 12a that is set on a take-up shaft 17 and that is also clamped by a clamp plate 19. Another end of the bag 12b is held down along a groove-like guide portion 13a by a keep-shaft 16 (see column 3, lines 32-54). Furthermore, the bag 12 is disclosed as completely shielding its contents from external light and fog (see column 4, lines 5-8). Thus, it is clear that the bag 12 of Kudo is an integral part of the invention, with which many of the other elements of the invention interact to provide the invention’s features. As a result, the device of Kudo would not function in the same manner if the bag were removed. The recording sheets contained within the bag would not be afforded the necessary shielding effect, and the elements that are disclosed as interacting with the bag (e.g., 16, 17, and 19) would be left as excessive elements having no purpose, which is clearly not what the inventor of the Kudo patent intended.

Moreover, Applicants respectfully submit that the features included in the present claims provide a novel and unobvious printing plate packaging box that is neither taught nor suggested by Kudo. As noted on page 4 of the specification, printing plate packaging boxes of the prior art require the photosensitive printing plates to be packaged in an internal wrapper. Kudo is an example of a device that requires an internal wrapper. Thus, during its use, it is necessary to first open the packaging box, take out the photosensitive printing plates (or sheets as in Kudo) that are contained in the internal wrapper, and then it is further required to open the internal wrapper having light-shielding properties.

The present invention provides a printing plate packaging box that does not require the use of an internal wrapper because of the claimed light-shielding member and the environment in which the claimed printing plate packaging box is used. Thus, because of these unique features, the present invention is different than the prior art, and can aid a manufacturing processes in a way not taught by the prior art that requires the internal wrapper.

Further, one skilled in the art would not have been motivated to remove the shielding bag 12 in light of its required interaction with the other disclosed elements and its relied upon shielding effects. Accordingly, Applicants respectfully submit that claims 8 and 30 are not obvious in light of Kudo, and request that the rejection thereof under 35 U.S.C. §103(a) be withdrawn. The rejection of dependent claim 27 should likewise be withdrawn, at least by virtue of it depending upon claim 8.

*Claims 8, 27 and 30*

Claims 8, 27 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Dirx (U.S. Patent No. 5,893,002).

The Examiner applies elements from Dirx in a manner similar to that found in the previous Office Action. The Examiner acknowledges that Dirx fails to disclose the features of claims 8 and 30 regarding the photosensitive printing plates which are not sealed with a light-shielding wrapper. Thus, the Examiner again relies on *In re Karlson* for an allegation that it would have been obvious to not wrap the “light-sensitive sheets” in a light shielding wrap. Applicants presume that the Examiner is referring to the light-type wrapping foils 29 and 30, as shown in Figures 5 and 6 (see column 3, lines 54-62). In response, Applicants direct the Examiner’s attention to the foregoing arguments in regard to the application of *In re Karlson*. That is, the Court in *In re Karlson* focused on whether the prior art device would still function in the same manner if elements were removed. However, similar to Kudo, the light tight wrapping foils 29 and 30 have a particular function that is integral to the cassette disclosed in Dirx. The foils 29 and 30 form light and air protection for the “light-sensitive sheets” (see column 3, lines 60 and 61). The wrapping foils 29 and 30 are also emphasized, in regard to Figure 8, as being relied upon to perform the air and light sealing function (see column 5, lines 53 and 54). If these elements were to be removed, the light-sensitive sheets disclosed in Dirx would not be afforded the needed protection from light and air. Thus, one would not have been motivated to remove these features, even if they could be removed.

Further, as a general assertion, Applicants respectfully submit that the rejections are unclear on their face for not containing the proper elements of a 35 U.S.C. §103 rejection, inasmuch as a rejection under 35 U.S.C. §103 requires the Examiner to set forth the following:

(A) The relevant teachings of the prior art relied upon, preferably with reference to the relevant, column or page numbers, and line numbers, where appropriate,

(B) The difference or differences in the claim over the applied references,

(C) The proposed modification of the applied references necessary to arrive at the claimed subject matter, and

(D) An explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

MPEP §706.02(j). In this case, the rejection does not, at least, set forth why one skilled in the art would have been motivated to make the modification proposed by the Examiner. Instead, the rejection merely asserts that it would have been obvious to modify the references so as to derive at the claimed features. However, Applicants respectfully point out that the Examiner cannot ignore the fundamental requirements of a 35 U.S.C. §103 rejection that necessitates the need for motivation to be found in references, or in the art in general, to modify the references. The Examiner has not set forth such motivation, nor did the references supply such motivation.

Accordingly, Applicants respectfully submit that the features of claims 8, 27 and 30 would not have been taught or suggested based on the teachings of Kudo and Dirx. Furthermore, one would not have been motivated to modify the references to obtain the claimed features.

*Claim 11*

Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over either of Kudo or Dirx in view of Lermer (U.S. Patent No. 5,495,944).

Applicants respectfully submit that claim 11 is patentable over the applied references at least by virtue of its dependency on claim 8. This is because the additional application of Lermer fails to make up for the deficient teachings of Kudo and Dirx. In particular, Lermer fails to disclose the claimed bundle of photosensitive printing plates that are not sealed within a light-shielding wrapper. Instead, Lermer discloses a medicine-type bottle, which the Examiner points out includes a shrink wrap. However, the shrink wrapping of an entire bottle with a thin polymeric film, as is often used on medicine bottles, would not have taught or suggested the presently claimed features of claim 11, which include a sheet-type material having a smooth and airtight surface that is adhered to an outer surface of an opening and closing lid of a printing plate packaging box. Instead, at best, if one were to apply the teachings of Lermer to that of the primary references, one would have been taught to shrink wrap the entire device of Kudo or Dirx. However, there is no motivation found in either Kudo, Dirx or the medicine bottle of Lermer to apply the thin polymeric film of Lermer to any portion of the primary references and, in particular, the opening and closing lid. Thus, Applicants respectfully submit that the rejection of claim 11 under 35 U.S.C. §103(a) should be withdrawn.

RESPONSE UNDER 37 C.F.R. §1.111  
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ART UNIT 3728  
Q65607

In view of the preceding remarks, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees (except the Issue Fee and/or the Publication Fee) to our Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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